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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) YOR919960049BX	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>July 24, 2006</u> Signature <u>Thomas A. Beck</u> Typed or printed name <u>THOMAS A. BECK</u>		Application Number 09/346,353	Filed 07/02/1999
		First Named Inventor MARIE ANGELOPOULOS	
		Art Unit 1714	Examiner YOON
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		Signature <u>Thomas A. Beck</u> Typed or printed name THOMAS A. BECK	
<input type="checkbox"/> applicant/inventor.		Telephone number 860 354 0892	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98)		Date 07/24/2006	
<input checked="" type="checkbox"/> attorney or agent of record. Registration number 20,816			
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AP, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
YOR919960049XB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Marie Angelopoulos, et al.
Serial Number : 09/346,353
Filing Date : July 2, 1999
Examiner : T. Yoon
Group Art Unit : 1714
For : METHODS OF FABRICATING
PLASTICIZED, ANTIPLASTICIZED AND
CRYSTALLINE CONDUCTING
POLYMERS AND PRECURSORS
THEREOF

The Honorable Assistant Commissioner of Patents
Post Office Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant is filing this Pre-Appeal based upon the fact that the rejections of record are clearly not proper and are without basis.

FACTS

The present invention is a method to fabricate electrically conducting polymer precursors and electrically conducting polymers in which the degree of crystalline regions and the degree of amorphous regions is adjustable. The method forms an admixture of a solvent, an additive and the polymers noted above. The solvent and the additive are not the same and the solvent is removed or partly removed and the additive provides an antiplasticization effect.

Claim 1 is essentially the broadest claim and reads as follows:

1. A method comprising forming an admixture of
a solvent,
an additive, said solvent being different from said additive and
a polymer selected from the group consisting of a precursor to an electrically conductive polymer and an electrically conductive polymer,
said precursor to said electrically conductive polymer being made electrically conductive by means of a doping reaction;
said polymer being soluble in said solvent,

said polymer not being substantially soluble in said additive in the absence of said solvent;
said additive provides local mobility to said polymer to allow regions of said polymer to associate with one another to achieve a crystalline state; and
removing or partly removing said solvent, substantially leaving said additive therein as remaining additive, said remaining additive provides local mobility to said polymer to achieve said crystalline state thereby comprising a polycrystalline material, said polycrystalline material is characterized by a degree of crystallinity regions and
a degree of amorphous regions, said degree of crystallinity regions and said degree of amorphous regions are selected by selecting the composition of said additive, and the amount of said additive;
forming a film from said admixture, said film possessing isotropic conductivity.

In the course of the prosecution of the instant application, to summarize, the Examiner rejected claims under 35 U.S.C. §102(b) as anticipated by or in the alternative 35 U.S.C. §103(a) as obvious over patents to Han, Cao, Ikkala and Elsenbaumer.

APPLICANT'S CONTENTION

The Examiner has rejected the claims using 35 U.S.C. §102(b) and/or §103(a).

For the claim(s) to be anticipated under §102 of the statute, each and every element found in Applicant's claims must be disclosed. The Examiner, in the many Official Actions issued in this case, has not applied the disclosure of the references to the elements claimed that would justify a valid anticipation rejection. Without the specific detailed application of the disclosure to the claim elements, Applicant is unable to provide a meritorious response which addresses the issues.

In his application of the references with respect to "obviousness, the Examiner relies *inter alia* upon "inherency." Applicant respectfully submits that it is improper to be rejecting a claim under 35 U.S.C. §103(a) based upon "inherency" such as the Examiner has consistently done in his rejections in this case.

The Court of Appeals for the Federal Circuit has clearly stated the standard which applies to the examination of applications for Letters Patent in holding:

*"[A] retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination."*In re Newell, 897 F.2d 899 13 USPQ2d 1056 (Fed. Cir. 1990).

The Examiner asserts that the cited art shows treatment of conducting polymers by plasticizers or solvents. The Examiner points to no teaching in these references to support the rejection based upon the substantive content of the claim. There is no teaching of isotropic electrical conductivity in these references, and the materials of these references are not made in the same fashion as applicants' materials. There is no suggestion in these references that the composition possesses isotropic electrical conductivity.

The Examiner has consistently taken the position that the disclosures of the references inherently meet the language of the claims. These rejections generally are based upon taking the reference to the limit of what it discloses, and via an unwarranted assumption, extrapolating the teaching to include what applicant has disclosed.

In the April 24, 2006 Official Action, the Examiner states that "Applicant failed to show how to achieve a polymer having amorphous and crystalline region from a conjugated diene forming an elastomer and a rubber. (sic) The specification does not show the instantly claimed method."

This is the assertion that the Examiner has made throughout the prosecution of this application. As noted below, Applicant has supported the limitations found in Claim 1 as to the crystalline and amorphous regions by referring to sections in the instant specification.

As noted above in Claim 1, Applicant states inter alia:

*"...removing or partly removing said solvent, substantially leaving said additive therein as remaining additive, said remaining additive provides local mobility to said conjugated polymer to achieve said crystalline state thereby comprising a polycrystalline material, said polycrystalline material is characterized by a degree of crystallinity regions and a degree of amorphous regions, said degree of crystallinity regions and said degree of amorphous regions are selected by selecting the composition of said additive, and the amount of said additive;
forming a film from said admixture, said film possessing isotropic conductivity.*

Attention is directed to the specification at page 12, line 18 through 15 line 13, copies of which were attached to the concurrently filed amendment as Exhibit A, which provides detailed support for the excerpt of claim 1 cited above. This disclosure is the foundation for establishing that the

present invention claims subject matter which is different in kind rather than degree from the prior art cited. See also Figs 6 and 11.

There is no disclosure in any of the references cited which meets each and every element of the excerpt of Claim 1 as set forth above; and, the assertion of inherency is improper with respect to an "obviousness" rejection.

As stated above, there is no teaching of, suggestion for or motivation for Applicants' invention as now claimed and thus there is no showing of *prima facie* obviousness. There is no proper rejection in the record based upon inherency, and inherency can not support an obviousness rejection, since what is inherent in a reference is not taught by the reference.

The Examiner has rejected the claims using the Elsenbaumer reference which does not full meet the statutory requirements for anticipation or obviousness. In order to complete the rejection he concludes the rejection with the comments :*"Also doping of the amorphous polyaniline film with aqueous hydrochloric acid (or any other dopant) would not change the morphology of solid film. Such method is different from the method taught by Elsenbaumer solution process, which would inherently yield the instant properties."*

In the statements made by the Examiner, he has *sua sponte* added information not taught in Elsenbaumer, but which is taught by applicants, i.e., the use of a solvent. In discussing the Elsenbaumer patent he has stated:

"Rejection is maintained for reason of record. The examiner repeats the following: the instant figure 5(a) is based upon polyaniline processed with NMP. There is no description whether the oxidizing dopant used in Elsenbaumer is utilized or not for said figure 5(a), and thus applicants' assertion the polyaniline film of Elsenbaumer is amorphous has no probative value. Also doping of the amorphous polyaniline film with aqueous hydrochloric acid (or with any other dopant) would not change the morphology of the solid film. Such method is different from the method taught by Elsenbaumer, solution process which would inherently yield the instant properties, and applicant failed to show otherwise." Emphasis added.

As noted above, it is improper to reject the claims as now amended in view of Elsenbaumer using an "inherency" assertion under 35 U.S.C. §103(a)

For the Examiner to properly make the assertions that he has on the record with respect to

rejecting the Applicants' claims over Cao, Han, Ikkala and Elsenbaumer, he must produce specific support for his assertions as to patentability or an Affidavit as provided for under 37 C.F.R. 104(d)(2) for the Examiner to qualify himself as an expert to make these statements. See, for example the excerpt cited above in which the Examiner comments on the "morphology of the solid film."

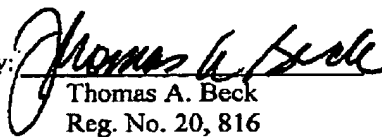
ACTION REQUESTED

1. Provide a detailed rejection of the claims pointing out the location at which each the alleged anticipatory references discloses the element in Applicant's claims.
2. Eliminate all reference to "inherency" as the basis for a 103(a) rejection.
3. Insure that the Examiner comply with the Federal Circuit holding that the Patent Office bears the burden of establishing obviousness. It held this burden can only be satisfied by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the reference.

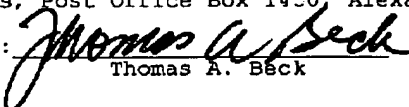
Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., 221 USPQ at 933.

Pursuant to the provisions of the Pre-Appeal Brief program, Applicant hereby declares that a Notice of Appeal has been filed concurrently with the submission of this brief. Any fees due on this matter should be charged to Deposit Account 50-0510.

Respectfully submitted,

By: 
Thomas A. Beck
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26 Rockledge Lane
New Milford, CT 06776

I hereby certify that this paper is being mailed via the United States Postal Service on the date indicated below addressed to The Commissioner of Patents & Trademarks, Post Office Box 1450, Alexandria, VA 22313-1450

Signature: 

Name:

Thomas A. Beck

Date: July 24, 2006

rejecting the Applicants' claims over Cao, Han, Ikkala and Elsenbaumer, he must produce specific support for his assertions as to patentability or an Affidavit as provided for under 37 C.F.R. 104(d)(2) for the Examiner to qualify himself as an expert to make these statements. See, for example the excerpt cited above in which the Examiner comments on the "morphology of the solid film."

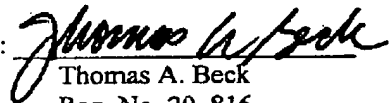
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Respectfully submitted,

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I hereby certify that this paper is being telefaxed to (571)273-8300 on the date indicated below addressed to The Commissioner of Patents & Trademarks, Post Office Box 1450, Alexandria, VA 22313-1450

Signature: 
Name: Thomas A. Beck

Date: July 24, 2006

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Under the Agreement Relating Act of 1982, no parties are required to accept or to participate in information which is exchanged as part of a dispute resolution process.

NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES		Case Number (Optional) YOK 919060049 BX	
I hereby certify that the correspondence is being deposited with the United States Patent Service with no patent pending as far as concerned by the applicant.		In re Application of MARIE ANGELOPOULOS	
Applicant's Name, Address, City, State, Zip Thomas A. Beck		Application Number 00/846,383	
Typed or printed name THOMAS A. BECK		Filed 07/02/1999	
		For Part No. 2 of Part 1007 USG ... POLYMERS AND PRECIPITATION	
		Ordnal Art Unit 1714	
		Examiner Yoon	

Applicants hereby oppose to the Board of Patent Appeals and Interferences from the final decision of the examiner.

The fee for this Notice of Appeal is (\$7 CFR 1.17(b)) **\$500**

☐ Applicant claims overall entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is \$_____.

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2026 is attached.

☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this check.

☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to the Deposit Account No. **60-6310**. I have enclosed a duplicate copy of this check.

☐ A petition for an extension of time under 37 CFR 1.136(a) (PTO/S272) is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-302A.

I am the:

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 1.71, Statement under 37 CFR 1.72(d) is enclosed. (Form PTO/S272)

☒ attorney or agent of record.

☐ attorney or agent acting under 37 CFR 1.34(a).
Registration number if acting under 37 CFR 1.34(a): _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest must be submitted and signed. Submit multiple forms if more than one signature is required, see below.

☐ Title of Invention is omitted.

Under this Agreement, this case is submitted to the U.S. Patent Service. This will be considered as the property of the Institution. All amounts on the greater of 10% per year shall be payable to the U.S. Patent Service Office, U.S. Patent and Trademark Office, Washington, DC 20503. NO FEE IS CHARGED FOR COMPLETED FORMS BY THE ADDRESS. SEE THE Published Correspondence for details. Washington, DC 20503.